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41. A computer readable memory having recorded thereon statements and instructions for execution by a computer to carry out the method of claim 15.
42. A computer readable memory having recorded thereon statements and instructions for execution by a computer to carry out the method of claim 16.
43. A computer readable memory having recorded thereon statements and instructions for execution by a computer to carry out the method of claim 17.

The claims in "clean form" are listed in Schedule "A" hereto.

The claims in "rewritten form" are listed in Schedule "B" hereto.

REMARKS

The Examiner is thanked for the above-mentioned Office Action.

The Examiner is reminded that it is essential for applicant to obtain a prompt yet complete examination of their application. Under the principles of compact prosecution, it is assumed that each claim has been reviewed by the Examiner for compliance with every statutory requirement for patentability, even if one or more claims are found to be deficient with respect to some statutory requirement. Consequently, it is assumed that the Examiner has stated all reasons and basis for rejecting the claims in the above-mentioned office action.

In the Office Action Summary, the Examiner indicated that Claims 1-17, 19 and 23 were rejected. In the Detailed Action, the Examiner only provided a basis for rejection to claims 1, 15-17.

In absence of any reason or basis for rejection to claims 2-14, and 23, allowance of these claims is hereby solicited.

Claims 1, and 15-17 were rejected under 35 USC § 101 on the basis that these claims:

- (a) Lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC § 101;

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- (b) Are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter;
- (c) Fail to fall within a statutory category; and
- (d) Are, at best, functional descriptive material *per se*.

Reconsideration of the rejection to Claims 1, and 15-17 is hereby solicited.

As written, 35 U.S.C. § 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define "things", while the first category defines "actions" (i.e. inventions that consist of a series of steps or acts to be performed).

However, 35 U.S.C. 100(b) states that the term "process" means process, art, or *method*, and includes a new use of a known process, machine, manufacture, composition of matter, or material. (Emphasis added)

It is therefore respectfully submitted that Claims 1 and 15-17, by using the word "method" in the preamble, fall *prima facie* within the statutory category of processes.

Consequently, the Examiner's assertion that these claims fail to fall within a statutory category is respectfully traversed.

Furthermore, the series of steps or acts to be performed in each of Claims 1 and 15 is clearly set out in the body of those claims immediately following the transition "comprising the steps of".

Likewise, the series of steps or acts to be performed in each of Claims 16 and 17 is clearly set out in the body of those claims immediately following the transition "by taking the following steps".

Consequently, the Examiner's assertion that these claims are not clearly a series of steps or acts to be a process is respectfully traversed.

With regards to the Examiner's assertion that these claims are, at best, functional descriptive material *per se*, the claims have been amended so as to further recite functional interrelationship between the elements involving the transformation or conversion of unclassified objects, either Internet objects or objects stored on computer readable media, in to classified objects. The classification is a useful, concrete and tangible result momentarily fixed in memory for classifying purposes.

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The district court in its State Street Bank¹ decision required that a computer implemented invention involve the transformation or conversion of subject matter that is representative or that constitutes physical activities or objects. The Federal Circuit in its State Street Bank² decision removed the requirement for physical transformation, and in its AT & T³ decision stated that physical transformation is merely one example of how a mathematical algorithm may bring about a useful application.

New dependent claims 25-39 have been added to better define aspects of the invention.

New article of manufacture claims 40, 41, 42 and 43 have been added, each of which finds correspondence and support in method claims: 1; 15; 16; and 17 respectively.

In view of the above remarks, reconsideration and allowance of the claims are respectfully requested.

Respectfully submitted,



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¹ State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 38 U.S.P.Q.2d (BNA) 1530, 1541 (D. Mass. 1996)
² State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 47 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1998), cert. denied, 525 U.S. 1093 (1999)
³ AT & T Corp. v. Excel Communications, Inc., 172 F.3d 1532, 50 U.S.P.Q.2d (BNA) 1447, 1452 (Fed. Cir. 1999)